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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/613,605	07/03/2003	David DeRogatis	RAILWA 3.0-001	7300
23562	7590	06/03/2005	EXAMINER	
BAKER & MCKENZIE PATENT DEPARTMENT 2001 ROSS AVENUE SUITE 2300 DALLAS, TX 75201			GARCIA, ERNESTO	
		ART UNIT		PAPER NUMBER
		3679		
DATE MAILED: 06/03/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/613,605	DEROGATIS ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Ernesto Garcia	3679	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on 13 May 2005.  
 2a) This action is **FINAL**.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 1,3,6-8,11-18 and 21-48 is/are pending in the application.  
 4a) Of the above claim(s) 6,12,14-18 and 21-48 is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1,3,7,8,11 and 13 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 13 May 2005 is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Election and Restriction*

Applicant's affirmation of the election of claims 1, 3, 7, 8, 11, and 13 in the reply filed on 5/13/05 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claims 6, 12, 14-18, 21-34 and 35-48 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention and species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on May 13, 2005.

Regarding the withdrawal of claim 6, the first engaging surface does have a shape being rectangular, pentagonal, hexagonal, octagonal or other regular polygons having at least four sides. Regarding the withdrawal of claim 12, this claim does not read on the elected species as the mating surface does not have threads. Regarding the withdrawal of claims 14 and 29, these claims do not read on the elected species as the mating surface is not flat but ball-shaped. Regarding the withdrawal of claims 15 and 16, these claims inherently become withdrawn since claim 14 is withdrawn. Regarding the withdrawal of claims 30-34, these claims inherently become withdrawn since claim

29 is withdrawn. Regarding the withdrawal of claim 17, the elected species, Figure 15A, does not have a cylindrical member.

***Drawings***

The drawings were received on May 13, 2005. These drawings are not acceptable.

The drawings filed May 13, 2005 do not comply with 37 CFR 1.121 as the drawings sheets were not label as "Replacement Sheet". Note, that the current label "Replacement Drawing" is not an option under rule 1.121. Further, Figure 15B was not part of that sheet as originally filed. Applicant needs to label each sheet accordingly as in 6/9 and 9/9 respectively. Further, Figure 15B is not a proper cross-section of Figure 15A and the reference to 15B-15B in Figure 15A needs to be deleted. Applicant needs to submit a new Figure showing the actual fastener of where the cross-section of Figure 15B was taken.

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "outermost diameter" line 3 of claim 1 and the "outer diameter" in line 6 of claim 1 must be shown or the features canceled from the claim. No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended". If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the examiner does not accept the changes, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: "the first engaging surface having an outermost diameter" as indicated in line 3 of claim 1, and "a mating surface having an outer diameter" recited in line 5 of claim 1.

The disclosure is objected to because of the following informalities: paragraph 057 indicates that the stop 222 is between the first section and the second section. However, Figure 15B shows the stop in the second portion 214 (i.e., the mating surface). Appropriate correction is required.

***Claim Objections***

Claim 1 is objected to because “such as a rail” in lines 1-2 should be deleted. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 3, 7, 8, 11 and 13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1, the limitation “outermost diameter” in line 3 is misleading.

According to Figure 15B it appears that the mating surface 214 also has an outermost diameter. Therefore, the diameter of the first engaging surface cannot be the outermost

diameter. Further, Figures 15A and 15B do not make reference to this outermost diameter to make someone understand the invention. Also, isn't the stop 222 a ridge?

Regarding claims 3, 7, 8, 11 and 13, the claims depend from claim 1 and therefore are indefinite.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3, 7, 8, 11 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Rapata, 3,539,234 (see marked-up attachment).

Regarding claim 1, Rapata discloses, in Figure 16, a plug fastener comprising a first engaging surface **A1** and a mating surface **A3**. The first engaging surface **A1** has an outermost diameter **A2**. The mating surface has an outer diameter **A100**.

Applicants are reminded that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ

138. Therefore, the outermost diameter **A2** can be adapted to frictionally engage an interior surface of an opening in a picket and the outer diameter **A100** can be adapted to frictionally engage with an interior surface of a second article. Further, it is inherent that frictional engagement of the first engaging surface and the mating surface will be sufficient to connect the picket to the second article.

Regarding claim 3, applicants are reminded that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138. Therefore, the plug fastener can be adapted to connect a picket at an acute angle or a right angle to a second article.

Regarding claim 7, the first engaging surface **A1** includes ridges **14h**. Applicant is reminded that the ridges **14h** can be adapted to frictionally engage an opening in a picket.

Regarding claim 8, the first engaging surface **A1** has a shape selected from a group consisting cylindrical, ellipsoidal, conical, elliptic conical frustum, pyramidal frustum, and ball.

Regarding claim 11, the mating surface **A3** includes ridges **14h**. Applicant is reminded that the ridges **14h** can be adapted to frictionally engage an opening in a second article.

Regarding claim 13, the mating surface **A3** has a shape selected from a group consisting of cylindrical, ellipsoidal, conical, elliptic, conical frustum, pyramidal frustum, and ball.

#### *Response to Arguments*

Applicant's arguments filed May 13, 2005 have been fully considered but they are not persuasive.

Applicants have argued that the device in Rapata is not capable of performing in the same manner as the claimed structure in the present application. In response, applicants have not proven why the device of Rapata will not work in the same manner as claimed. Applicants have argued that the device in Rapata cannot perform that function without preventing the device from performing its own intended function. Again, nothing in this statement proves that the device of Rapata would not work. The fact that the device of Rapata performs its intended function does not negate performance of other functions. For instance, it is well known that a pencil was invented for writing, but a pencil can also be adapted to puncture a hole on a plastic bag, or even

used to stir liquids. Therefore, the pencil's intended function does allow other functions. The same logic applies to Rapata.

Applicants have argued that the structure of Rapata's device could not be used to engage two separate openings to connect two parts together since to do so would then block the shaft or stud member from being inserted within the bushing. In response, it is unclear how the shaft or the stud member will be blocked from being inserted within the bushing when applicant already has admitted in lines 7-11 that a shaft is received within the bore of the Rapata's device. Further, none of the claims recite "a shaft within the plug fastener". Therefore, the shaft is not required.

Applicants have argued that the bushing could not provide the "rotational and angular movement" to the shaft desired by Rapata because the shat would contact the interior surfaces of the openings when attempting to move it in the specified manner. Applicants are reminded that this argument is out of scope, as the question of patentability is concerned with applicants' invention and not of Rapata's invention. The limitation "rotational and angular movement" is not found in applicants claimed invention and it has no relevance to patentability. Further, applicants have remarked that "the claimed fastener connects two separate pieces". Applicants should note that the claimed invention does not recite the "plug fastener connecting two separate pieces" to render a positive connection. All that is required is a plug fastener that is able to be

adapted to connect a picket to a second article. Therefore, the plug fastener of Rapata is able to be adapted to connect a picket to a second article.

Applicants have further argued that the Rapata's device expressly intends that the shaft be received through the bushing to rotate and pivot with respect to the workpiece, and that the Rapata device could not receive a screw through its openings. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., a screw through the openings of the plug fastener) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). If applicant is arguing the capability that a screw cannot be inserted in the plug fastener of Rapata because a shaft is already in the openings, one merely has to remove the shaft and insert the screw. Therefore, the plug fastener of Rapata is capable of having a screw inserted in the opening of the fastener. There is nothing about the openings that will prevent a screw from being inserted in the opening.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ernesto Garcia whose telephone number is 571-272-7083. The examiner can normally be reached from 9:30-5:30. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular communications and 703-872-9327 for After Final communications.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached at 571-272-7087.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*E.G.*

May 23, 2005

*Daniel P Stodola*

DANIEL P. STODOLA  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600

Attachment: one marked-up copy of Rapata, 3,539,234.

Accordingly, Applicants respectfully request that these objections to the specification also be withdrawn.

Furthermore, an Examiner Interview between the Examiner and the prior Attorney for Applicants, Diana Rea, took place on December 1, 2004. In that Interview, the cited Rapata reference (U.S. Patent 3,539,234) was discussed, as well as proposed amendments to the then-pending claims. The Examiner issued an Interview Summary (Form PTOL-413) setting forth an official record of the Interview, and that no agreement could be reached at that time. Because no agreement could be reached, Applicants did not file the proposed claim amendments in this Application. Moreover, Applicants have no objection to the Interview Summary prepared by the Examiner.

*"interview record OK"  
P.J. 5/20/05*

## **II. REJECTIONS UNDER 35 U.S.C. §112**

The Examiner has rejected independent claim 1 under 35 U.S.C. §112, second paragraph, as allegedly failing to particularly point out and distinctly claim the subject matter which the Applicants regard as the invention. Specifically, the Examiner states that the use of the term "maximum diameter" in claim 1 is a relative term, and therefore indefinite without referencing a feature with which to compare this diameter. While the Applicants do not necessarily agree with the Examiner's position, the Applicants have amended claim 1 to remove this limitation, since it unnecessarily limits the scope of the claims. Since the limitation at issue has been removed, Applicants respectfully request that the rejection of claim 1 and its dependent claims under §112, second paragraph, be withdrawn.

## **III. REJECTIONS UNDER 35 U.S.C. §102**

The Examiner has rejected independent claim 1 and its dependent claims under 35 U.S.C.

(Rapata) 3,539,234

